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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,754	12/14/2001	Yevgeniy Eugene Shteyn	US018202	2525

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EXAMINER

ZHOU, TING

ART UNIT	PAPER NUMBER
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2173

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/022,754

Applicant(s)

SHTEYN, YEVGENIY EUGENE

Examiner

Ting Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/14/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on 30 October 2006 under 37 CFR 1.53(d) based on parent Application No. 10/022,754 is acceptable and a RCE has been established. An action on the RCE follows.
2. The amendments filed on 30 October 2006, submitted with the filing of the RCE have been received and entered. The applicant has added new claims 8-9. Claims 1-2, 4 and 6-9 as amended are pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106.01 reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

4. Claim 7 defines a software application. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" - MPEP 2106.01). Claim 7 is directed to software, per se, lacking any hardware to enable functionality to be realized. Therefore, the claimed features of claim 7 is actually a software, or at best, directed to an arrangement of software, and software claimed by itself, without being executed or implemented on a computer medium is not statutory. That is, the scope of the presently claimed software application can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Claim 9 is rejected for similar reasons. Any amendment to the claim should be commensurate with its corresponding disclosure.

5. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grover et al. U.S. Patent 5,818,437 (hereinafter "Grover") and Roth et al. U.S. Publication 2005/0038657 (hereinafter "Roth").

Referring to claims 1 and 7, Grover teaches a device and software application comprising an ambiguous first data input system configured to associate a first user input with a plurality of potential data (the set of nine data keys representing a plurality of letters and symbols yielding a plurality of matches for the entered keystroke) (Grover: column 1, lines 46-55, column 3, lines 66-67, column 4, lines 34-40 and Figure 1), a second data input system receiving second user input independent from the first data input system receiving a second user input (receiving user input via moving the cursor or highlight bar between the list of potential data with the "select key", which is a system level input key that is different from the set of data keys) (Grover: column 1, lines 55-58, column 4, lines 6-9 and 40-43), and a processing unit coupled to the first

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and second input systems for selecting one of the plurality of potential data based on the second user input (the user selects one of the plurality of potential data using the “select” key 104 shown in Figure 1 and the processing unit of the portable computer subsequently inserts and displays the selected word in display area 101) (Grover: column 1, lines 55-58, column 4, lines 43-45 and Figure 2), wherein the first data input system comprises manual input device (users manually input selection on the keypad) (Grover: column 1, lines 46-47, column 3, lines 66-67 and column 4, lines 34-37), and the second data input system is a speech recognition input system, a handwriting input system, or a stylus input system (the user can select the desired word from the word selection list using the keystroke input of the “select key” 104 on the touch-sensitive display; however, the keystroke input, i.e. the second data input system, can also be made with any pointing device such as a mouse or light pen) (Grover: column 1, lines 55-58, column 4, lines 43-45, column 9, lines 19-25 and Figure 1). However, although Grover teaches that the first and second user input systems are independent from each other, Grover fails to explicitly teach that the two input systems are unassociated with each other. Roth teaches a graphical user interface for recognition of user inputs similar to that of Grover. In addition, Grover further teaches unassociated input systems (users can switch between different modes of input, i.e. switching between speech recognition and keyboard inputs) (Roth: page 3, paragraph 0059 and page 23, paragraphs 0328-0329). It would have been obvious to one of ordinary skill in the art, having the teachings of Grover and Roth before him at the time the invention was made, to modify the graphical user interface comprising the first and second user inputs of Grover to include the switching between unassociated input methods of Roth. One would have been motivated to make such a combination in order to allow users to switch back and forth between

different modes depending upon which is most convenient at the current time (Roth: page 23, paragraphs 0328-0329).

Referring to claim 2, Grover, as modified, teach a display coupled to the processing unit and configured to display the selected potential data (display 602 shown in Figure 2) (Grover: column 3, lines 58-63).

Referring to claim 4, Grover, as modified, teach the first data input system comprises a touch-sensitive screen (Grover: column 3, lines 58-63 and Figure 2).

Referring to claim 6, Grover, as modified, teach the processing unit further determines the selected data based on a dictionary database internally or remotely accessed (the processor processes the keystroke sequence with a dictionary) (Grover: column 1, lines 51-55).

Referring to claims 8-9, Grover, as modified, teach wherein the first data input system comprises a real or virtual keyboard configured to associate a specific keystroke with a plurality of graphical characters (keypad with nine data keys, each associated with a plurality of letters and symbols) (Grover: column 1, lines 46-47, column 3, lines 66-67 and column 4, lines 34-37).

Response to Arguments

7. Applicant's arguments with respect to claims 1-2, 4 and 6-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ



Kien Vu

Primary Examiner